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# Fax Cover Sheet

Date: 17 Jun 2005

To: Brian Dutton	From: Frantzy Poinvil
Application/Control Number: 09/774,682	Art Unit: 3628
Fax No.: 202-955-3751	Phone No.: (703) 305-9779
Voice No.:	Return Fax No.: (703) 872-9306
Re:	CC:

☒ Urgent ☐ For Review ☐ For Comment ☐ For Reply ☒ Per Your Request

**Comments:**

The finality of the prior Office action has been withdrawn. The time for responding to the Office action has been restarted.


SON-2024

Number of pages \_\_ including this page

**STATEMENT OF CONFIDENTIALITY**

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 <b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/774,682	ASANO ET AL	
Examiner	Art Unit		
Frantzy Poinvil	3628		

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. The applicant's representative indicated to the Examiner that the prior Office action should not have been made final since it had appeared that a new ground of rejection was introduced therein.
2. In response, the Examiner now withdraws the finality of the prior Office action, and regrets the inconvenience.
3. A new rejection is found below.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonaka et al. (GB 2,303,956) (hereinafter Nonaka).

Nonaka teaches (see at least the abstract, Figures 1-13, and pages 1-53, but in particular the locations cited below):

An electronic-money settlement method comprising the steps of  
recording, in a portable electronic device and a management center, information on a deposited amount of money, said information being stored in said portable electronic device in the form of electronic money representing a monetary value (1); and

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recording, said portable electronic device and said management center, information on a loan made to the user of said portable electronic device up to a predetermined limit (Figure 2a and 2b and 5 and 10 show the format of the data storage in the IC, Figure 13 shows the functions within the IC card and communication with management center, and Figures 3,4, 6,8, 11, 12a and b show the steps involved in Nonaka, including the updating, storage and communication of information). Nonaka teaches several conditions for recording information in the portable device and in the management center. Recording information on the portable device and at the management center based on conditions such as "when a payment amount exceeds the remaining amount of the electronic money stored in said portable electronic device" is only one of a multitude of possible conditions that would have been left to the users/owners described by Nonaka since such would not affect the functioning of the system of Nonaka. Doing so would have enabled preferred usability of the system of Nonaka as all the claimed functionalities are enabled by the system of Nonaka.

As per claim 2, a electronic-money settlement method according to claim 1, wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan is taught on (S122 and S224). Furthermore, interests are usually charged by loan providers which would have been obvious to do in the system of Nonaka for profit purposes.

As per claim 3, an electronic-money settlement method according to claim 1, determining when the loan exceeds a predetermined limit is illustrated in figure 4, element S211 of Nonaka.

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The management center prohibiting the use of the electronic money by the portable electronic device (S2111) would have been obvious to one of ordinary skill in the art to do because the user would have exceeded the user's limit and the user's allowable funds had been exhausted thus preventing further debts to be owed by the user.

As per claim 4, an electronic-money settlement method according to claim 1, wherein said management center updates a record of the remaining amount of the electronic money stored in said portable electronic device when being instructed to store electronic money in said portable electronic device, and updates the remaining amount of the electronic money stored in said portable electronic device is taught and discussed throughout Nonaka. Doing so, when being accessed by said portable electronic device so that priority is given to liquidation of the loan is not explicitly taught by Nonaka. Doing so would have enabled preferred usability of the system of Nonaka as all the claimed functionalities are enabled by the system of Nonaka. Doing so, when being accessed by said portable electronic device so that priority is given to liquidation of the loan (S226) would have been obvious to do in the system of Nonaka in order to reduce the debts of the owners of the system of Nonaka.

As per claims 5 and 6, claims 5 and 6 are apparatus claims reciting features found in claims 1 and 2. Nonaka is directed to an apparatus for providing a loan to a user of a portable device and recording such in the portable device and at a management system. See pages 4-13 and the abstract of Nonaka. Claims 5 and 6 recite similar functions found in claims 1 and 2, and therefore are rejected under a similar rationale.

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As per claims 7 and 8, these claims contain features recite in claims 1 and 2 and claims 7 and 8 are rejected under a similar rationale. As per features regarding a transaction history and loan information being transmitted to the management center, see pages 4-13 of Nonaka.

The processes of maintaining records of values used, payments made, loan amounts extended, balances of values and loan amounts, both within the IC card and at the management center, and communicating/displaying all of this information to both the management center and the user are all old and well known for portable electronic devices used for financial transactions. It would have been obvious to one skilled in the art at the time of the invention to have been fully aware of these standard processes, and to have utilized that knowledge to have made and used this invention prior to its application date.

## 5. Response to Applicant's Arguments

Nonaka does not teach the same terminology for some of the more obvious mechanical steps normally used for these standard record keeping and communication processes, but Nonaka does teach the same functions. See specifically the abstract for the examples of functions that the applicant argues do not exist in Nonaka. Relative to the issue about the steps described for figure 1, that figure has 5 blocks of functions labeled 1-5, which contains functions 1 1-14, 21-26, 31-38, and 51-54. Figure 2a and 2b and 5 and 10 shows the format of the data storage in the IC, Figure 13 shows the functions within the IC card and communication with

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management center, and Figures 3,4, 6, 8, 11, 12a and b show the steps involved in Nonaka, including the updating, storage, and communication of information.

### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3628**

FP  
June 14, 2005